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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,303	11/22/2000	Michelle Q. Wang Baldonado	001508-3160	8448
7590 NIXON PEABODY LLP Clinton Square P.O. Box 31051 Rochester, NY 14603				
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EXAMINER				
BAYARD, DJENANE M				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/717,303

Applicant(s)

WANG BALDONADO ET AL.

Examiner

DJENANE M. BAYARD

Art Unit

2444

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 5, 6, 8, 9, 11, 13, 14, 16, 17, 19, 21, 22, 24, 25, 31-33 and 39-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-6, 8-9, 11, 13-14, 16-17, 19, 21-22, 24-25, 31-33, 39-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to communication filed on 3/24/09 in which claims 1, 3, 5-6, 8-9, 11, 13-14, 16-17, 19, 21-22, 24-25, 31-33, 39-47 are pending.

Response to Arguments

2. Applicant's arguments have been fully considered but they are not persuasive. Applicant argues that the combination of Knight in view of Burnstein fails to teach "querying users that are already participating in the same first forum, and are not users who are disparately searching. However, Knight clearly teaches wherein content can be extracted from a **particular discussion board**, thus limiting the extraction to whatever forum the user chooses (See col. 9, lines 41-66).

As per claim 8, Applicant argues that the combination of Knight-Burnstein fails to teach " wherein the information comparison is based on a rule-based model and a statistical-based model". However, Knight clearly teaches the content is extracted from these sources according to set of rules, filters or criteria specified by the online provider, and/or gleaned from community based traffic monitoring (See col. 9, lines 21-25 and col. 25, lines 16-24).

As per claim 39, it is well known to one with ordinary skill in the art that a comparison must be made between new message and old message since the message traffic monitor and analyze all user queries, commands, posting etc.. to tabulate the information discussed (See col. 24, lines 50-65).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 5-6, 8-9, 11, 13-14, 16-17, 19, 21-22, 24-25, 31-33 and 39-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,778,982 to Knight et al in view of U.S. Patent Application No. 2002/0032735 to Burnstein et al.

a. As per claims 1, 9 and 17, Knight et al teaches an online content provider system and method for compiling, creating and presenting content to users. Furthermore, Knight et al teaches an information monitoring device adapted to monitor one or more electronic documents in an information stream associated with a first electronic forum, and compares information about the one or more electronic email documents to two or more rules (See col. 9, lines 43-50 and col. 22, lines 35-44), *Remark: Knight teaches first kind of extraction robot of the present invention periodically retrieve content from outside sources and online message board system. The content is extracted from these sources according to set of rules, filters or criteria specified by the online provider, and/ or gleaned from community based traffic monitoring*); Furthermore, Knight et al teaches a forum wherein the two or more rules comprise at least two of the following: how long the electronic forum has been in use; how many email messages have been exchanged on the electronic forum; whether there has been a suggestion to create a new

discussion forum; whether a certain number of email messages on a particular topic been received within a predetermined time period; whether the rate of email messages exchanged on a particular topic been statistically greater than normal; or whether a certain number of forum members exchanged email messages on a particular topic within a predetermined time period (See col. 20, lines 22-32 and col. 24, lines 52-65). However, Knight et al fails to teach forum spawning device adapted to query a set of users when at least two of the at least two or more rules is satisfied and creates a new forum based on one or more replies from the set of users and a subscriber determining device adapted to determine which of the queried users indicate interest in the new electronic forum and subscribes each interested user to the new electronic forum, but does not subscribe users of the set who do not indicate interest in the new electronic forum.

Burnstein et al teaches an automatic telephone, internet or intranet community formation. Furthermore, Burnstein et al teaches wherein an invention that contacts the currently searching and the previously searching users and asks them if they want to join a new community on the topic of the search string in the following manner. Initially the current searching user is contacted by the invention automatically. If that person indicates their interest in joining a community then the second action of the invention is to locate non-searching user(s) in the matched field and contacted them and ask if they want to join this community. If each answers in the affirmative, the invention automatically forms a new community and the users are entered as members of that community (See page 8, paragraph [0098]). Furthermore, Burnstein et al teaches a subscriber determining device that determines which of the queried users indicate interest in the new electronic forum and subscribes each interested user to the new electronic

forum, but does not subscribe users of the set who do not indicate interest in the new electronic forum (See page 8, paragraph [0098 and 0100-0101]). Furthermore, Burnstein et al teaches wherein the input can be E-mail (See page 8, paragraph [01001]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate forum spawning device that queries a set of users when at least one of the at least one rules is satisfied and creates a new forum based on one or more replies from the set of users as taught by Burnstein et al in the claimed invention of Knight et al in order to invite the match parties to join a frictionless and immediate electronic community if they so desire (See page 1, paragraph [0013]).

b. As per claims 3, 11, and 19, Knight et al in view of Burnstein et al teaches the claimed invention as described above. However, Knight et al fails to teach wherein the forum spawning device queries the set of users to determine the need for the new forum.

Burnstein et al teaches wherein the forum spawning device queries the set of users to determine the need for the new forum (See page 8, paragraph [0098]).

I would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the forum spawning device queries the set of users to determine the need for the new forum as taught by Burnstein et al in the claimed invention of Knight et al in order to invite the match parties to join a frictionless and immediate electronic community if they so desire (See page 1, paragraph [0013]).

c. As per claims 5, 13 and 21, Knight et al in view of Burnstein et al teaches the claimed invention as described above. However, Knight et al fails to teach a subscriber maintenance device that associates the new electronic forum and a set of users indicating interest in the new electronic forum.

Burnstein et al teaches a subscriber maintenance device that associates the new electronic forum and a set of users indicating interest in the new electronic forum (See page 8, paragraph [0098-0101]).

I would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the forum spawning device queries the set of users to determine the need for the new forum as taught by Burnstein et al in the claimed invention of Knight et al in order to invite the match parties to join a frictionless and immediate electronic community if they so desire (See page 1, paragraph [0013]).

d. As per claims 6, 14 and 22, Knight et al in view of teaches the claimed invention as described above. Furthermore, Knight et al teaches an electronic document storage device that stores the one or more electronic documents (See col. 22, lines 35-44). However, Knight fails to teach wherein the message can be e-mail.

Burnstein et al teaches wherein the input can be E-mail (See page 8, paragraph [01001]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate forum spawning device that queries a set of users when at least one of the at least one rules is satisfied and creates a new forum based on one or more replies from the set of users as taught by Burnstein et al in the claimed invention of Knight et al in order to invite

the match parties to join a frictionless and immediate electronic community if they so desire (See page 1, paragraph [0013]).

e. As per claims 8, 16 and 24, Knight et al teaches wherein an information comparison is based on at least one of a rule-based model and a statistical-based model (col. 9, lines 25-65).

f. As per claim 25, Knight et al teaches the information storage media wherein an information comparison compares at least one of subject information; electronic document posting information; and document tracking information (See col. 9). However, Knight fails to teach wherein the message can be e-mail.

Burnstein et al teaches wherein the input can be E-mail (See page 8, paragraph [01001]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate forum spawning device that queries a set of users when at least one of the at least one rules is satisfied and creates a new forum based on one or more replies from the set of users as taught by Burnstein et al in the claimed invention of Knight et al in order to invite the match parties to join a frictionless and immediate electronic community if they so desire (See page 1, paragraph [0013]).

g. As per claim 31-33, Knight et al teaches wherein the information stream comprises one or more electronic messages flowing between two or more of the users (See col. 5, lines 3-10). However, Knight fails to teach wherein the message can be e-mail.

Burnstein et al teaches wherein the input can be E-mail (See page 8, paragraph [01001]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate forum spawning device that queries a set of users when at least one of the at least one rules is satisfied and creates a new forum based on one or more replies from the set of users as taught by Burnstein et al in the claimed invention of Knight et al in order to invite the match parties to join a frictionless and immediate electronic community if they so desire (See page 1, paragraph [0013]).

h. As per claims 39, 42 and 45, Knight et al in view of Burnstein et al teaches the claimed invention as described above. Furthermore, Knight et al teaches wherein the comparison is between newer email messages and older messages to determine when a new topic of conversation has begun (See col. 24, lines 52-65).

i. As per claims 40, 43 and 46, Knight et al in view of Burnstein et al teaches the claimed invention as described above. Furthermore, Knight et al teaches wherein the information monitoring device detects whether the new topic of conversation is likely to generate additional messages (See col. 10, lines 5-10). However, Knight fails to teach wherein the message can be e-mail.

Burnstein et al teaches wherein the input can be E-mail (See page 8, paragraph [01001]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate forum spawning device that queries a set of users when at least one of the at least one rules is satisfied and creates a new forum based on one or more replies from the

set of users as taught by Burnstein et al in the claimed invention of Knight et al in order to invite the match parties to join a frictionless and immediate electronic community if they so desire (See page 1, paragraph [0013]).

j. As per claims 41, 44 and 47, Knight et al in view of Burnstein et al teaches the claimed invention as described above. Furthermore, Knight et al teaches wherein the subscribers to the new electronic forum receive messages form both the first electronic forum and the new electronic forum (See col. 10). However, Knight fails to teach wherein the message can be e-mail.

Burnstein et al teaches wherein the input can be E-mail (See page 8, paragraph [01001]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate forum spawning device that queries a set of users when at least one of the at least one rules is satisfied and creates a new forum based on one or more replies from the set of users as taught by Burnstein et al in the claimed invention of Knight et al in order to invite the match parties to join a frictionless and immediate electronic community if they so desire (See page 1, paragraph [0013]).

5. Claims 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,778982 to Knight et al in view of U.S. Patent Application No. 2002/0032735 to Burnstein et al as applied to claims 1, 9, 17 and 26 as applied above, and further in view of U.S. Patent Application No. 2002/0059164 to Shtivelman.

a. As per claims 35-38, Knight et al Burnstein et al teaches the claimed invention as described above. However, Knight et al in view of Burnstein et al teaches wherein the one or

more rules comprise at least one of the following: how long the current discussion forum has been in use; how many email messages have been exchanged on the forum; whether there has been a suggestion to create a new discussion forum; whether a certain number of email messages on a particular topic been received within a predetermined time period; whether the rate of email messages exchanged on a particular topic been statistically greater than normal; or whether a certain number of forum members exchanged email messages on a particular topic within a predetermined time period.

Shtivelman teaches whether a certain number of forum members exchanged messages on a particular topic within a predetermined time period (See page 5, paragraph [0052]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate whether a certain number of forum members exchanged messages on a particular topic within a predetermined time period as taught by Shtivelman in order to calculate new message load/responses parameters (See page 5, paragraph [0052]).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DJENANE M. BAYARD whose telephone number is (571)272-3878. The examiner can normally be reached on Monday- Friday 5:30 AM- 3:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharja can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. M. B./
Examiner, Art Unit 2444
/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2444